

**REMARKS**

Claims 1 through 25 are pending. Claim 26 has been canceled. Reconsideration of the application is requested.

**I. Rejections Under 35 U.S.C. § 112**

Claim 10 was rejected under 35 U.S.C. § 112, second paragraph. Claim 10 has been amended to correct a typographical error, and the rejection of claim 10 under 35 U.S.C. § 112 is believed to have been overcome.

**II. Rejections Under 35 U.S.C. §102**

Claims 1 through 5, 8, 9, and 20 through 25 were rejected under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent No. 3,464,412 (Schwartz). The Examiner indicated that Schwartz describes each element of claim 1 of the present invention, but does not disclose that “movement of said activator member towards said dispensing opening causes movement of said application member so that said channel between said main chamber and said auxiliary chamber is formed.” Office Action at page 8. The Examiner concluded, however, that the device of Schwartz includes the structures capable of performing the movement of the activator member towards the dispensing opening, and is capable of causing movement of the applicator member so that the channel between the main chamber and the auxiliary chamber is capable of being formed. Applicants respectfully disagree with the rejection, and request reconsideration of the rejected claims for at least the following reasons.

Schwartz describes a syringe combination having an outer housing and a hollow plunger that provide a pair of chambers. The plunger is provided with a piston having a plurality of spaced, ring-like sealing surfaces, and with a fluid passageway from the interior of the plunger to the outer piston surface (between ring-like sealing surfaces). A fluid is stored in the interior of the plunger, and a powder is stored in the portion of the outer housing that is forward of the piston. To mix the fluid and powder, the plunger 30 is slowly pulled towards the rear of the housing 20 until the first and second rings 33 of the piston 32 pass by the fluid bypass 24, as shown in Figure 2. As the plunger 30 is drawn back, the volume of the housing interior expands, resulting in an area of lower pressure in the housing 20. The reduced pressure in the housing causes the fluid to flow from the

plunger passageway 34 into the interior of the housing 20, where the liquid and the powder can mix. Then the plunger can be pushed forward as shown in Figure 3 to dispense the combined material from the syringe.

Schwartz does not anticipate claim 1 of the present invention under 35 U.S.C. § 102(b) because it does not disclose each element of the claimed invention arranged in the same way as claimed. “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed, and, thus, cannot anticipate under 35 U.S.C. § 102(b).” *Net Moneyin, Inc., v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

Schwartz does not include each element of the claimed invention, and three elements are certainly not arranged as required by claim 1 of the present invention. First, claim 1 recites that “said through-hole and said recessed area [form] a channel between said main chamber and said auxiliary chamber upon activation of said capsule by said activator member. . . .” Schwartz, in contrast, is not activated by the feature referred to in the Office Action as the activator member (movable piston 35). Instead it is activated when the inner plunger 30 is pulled backwards to create the pressure differential. The movable piston 35 is not used to activate, but is merely “permitted to slide forward in the barrel of the plunger 30 . . . to replace the fluid as the fluid is drawn into the housing by the negative pressure induced within the outer housing.” Col. 5, ll. 19-23. It therefore does not function in the manner claimed in claim 1.

Second, Schwartz does not disclose “movement of said activator member *towards said dispensing opening* cause[ing] movement of said applicator member so that said channel between said main chamber and said auxiliary chamber is formed,” as required by claim 1. In fact, the device of Schwartz is not capable of activation by movement of an activator member “*towards said dispensing opening*” at least because the fluid passageway 34 of the piston 32 is already arranged “forwardly or inwardly of the fluid bypass 24,” as shown in Figure 1. This is a second example of the structure of Schwartz not being arranged in the manner claimed in claim 1.

Third, Schwartz specifically teaches activation by drawing the plunger away from the dispensing end so that reduced pressure is created in the housing, ultimately causing the fluid to

flow through the passageway. It is not clear how the elements of Schwartz could even be re-arranged to meet the limitations of claim 1, much less result in a functioning device. The device of Schwartz does not describe each element of claim 1, arranged as recited in the claim, and thus cannot anticipate claim 1 under 35 U.S.C. § 102(b). Claim 1 is believed to be in condition for allowance, and it is respectfully requested that the rejection be withdrawn. Claims 2 through 5, 8, 9, and 20 through 25 include the limitations of claim 1, and are therefore similarly in condition for allowance.

III. Rejection of Claims 1 through 5, 8 through 9, and 20 through 25 Under 35 U.S.C. § 103

Claims 6, 7, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz in view of U.S. patent No. 2,754,590 (Cohen.) Claims 1 through 5, 8, 9, and 20 through 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz in view of U.S. Patent No. 2,754,590 (Cohen). The Examiner indicated that Schwartz discloses the subject matter of claim 1 with the exception that Schwartz does not disclose that “movement of said activator member towards said dispensing opening causes movement of said applicator member so that said channel between said main chamber and said auxiliary chamber is formed.” The Examiner stated that Cohen discloses such a feature and concluded that it would have been obvious to one having ordinary skill in the art to have combined the references, and that the resulting device would have rendered the claimed invention obvious. Applicants respectfully disagree for at least three reasons, and request that the rejection be withdrawn.

First, Schwartz does not disclose “*activation of said capsule by said activator member*” as required by claim 1. Contrary to the characterization of the Office Action, the piston 35 of Schwartz does activate the capsule and thus does not disclose or suggest the activator member of claim 1. As described above, the capsule of Schwartz is activated when the inner plunger 30 is pulled a certain distance toward the rear of the housing. The piston 35 is merely “drawn forwardly to replace the fluid as the fluid is drawn into the housing by the negative pressure” (Col. 5, ll. 20-24) and serves to prevent exposure of “the fluid in the plunger to atmospheric pressure or to possible contamination.” Col. 5, ll. 17-19. According to the present invention, however, application of a force by the user on the *activator member* causes the activator member and the applicator member to move into the capsule body. As a result, the main chamber and the

auxiliary chamber become connected with each other via the bypass 104, and the through-hole 112. The piston 35 does not activate the capsule of Schwartz and thus Schwartz does not disclose or suggest the “activation of said capsule by said activator member” as required by claim 1 of the present invention.

Second, Cohen does not cure the deficiencies of Schwartz described just above. Although the Office Action indicates that the washer 26 of Cohen corresponds to the activator member of claim 1, causing movement of the applicator member to form a channel between the main chamber and the auxiliary chamber, no such activator member is suggested by Cohen. As indicated in the Figures and the written description in Cohen, the washer 26 is engaged after activation of the capsule, “forming a solid head or piston, which allows the piston to eject the contents of the syringe into a cavity in a tooth.” Col. 3, ll. 103. The washer 26 does not cause movement of an applicator member “so that said channel between said main chamber 18 and said auxiliary chamber 17 is formed,” as required by claim 1. It is only after the contents of cylinders 17 and 18 have been thoroughly mixed that the washer 26 is engaged to facilitate dispensing of the mixture. Col. 2, ll. 68-72. As a result, Cohen lacks any disclosure or suggestion of the portions of claim 1 lacking from Schwartz, and thus does not render claim 1 unpatentable under 35 U.S.C. § 103(a) either alone or in combination with Schwartz.

Third, even if Schwartz were combined with Cohen in the manner suggested in the Office Action, a functional device having the elements of claim 1 would not result. It is not clear how the device of Schwartz - activated when rearward motion creates a pressure differential - could ever be combined with the device of Cohen - activated by a reciprocating plunger - to result in a device in which movement of an activator member towards the dispensing opening causes movement of an applicator member, forming a channel between the main chamber and auxiliary chamber. The functionality of Schwartz is based on a pressure differential that draws the fluid into the forward interior of the housing. Cohen operates on an entirely different principle, and the substitution of components from one into the other does not lead to a device that would even function, much less a device that renders obvious the subject matter of claim 1.

Ultimately, Schwartz does not disclose “activation of said capsule by said activator member,” Cohen does not cure the deficiencies of Schwartz, and, even if Cohen did disclose the elements of claim 1 lacking from Schwartz, the references cannot be combined to create a

functional device having the elements of claim 1. Claims 2 through 5, 8, 9, and 20 through 25 all include the limitations of claim 1, and are therefore patentable for at least the same reasons.

Therefore, Applicants respectfully request that the Examiner's rejection of claims 1 through 5, 8, 9, and 20 through 25 be withdrawn.

IV. Conclusion

All outstanding matters are believed to have been addressed, and the pending claims are believed to be in condition for allowance. Accordingly a notice of allowance for those claims is respectfully requested. If a telephonic conference with the Applicants' undersigned representative would be useful in resolving any outstanding matters in this application, the Examiner is invited to contact the undersigned at 651-736-4050.

Respectfully submitted,

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